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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,636	04/14/2004	Marlene C. Schwarz	12013/47401	4614
23838	7590	02/01/2006	EXAMINER	
KENYON & KENYON LLP			CAMERON, ERMA C	
1500 K STREET N.W.			ART UNIT	PAPER NUMBER
SUITE 700				
WASHINGTON, DC 20005			1762	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/823,636	SCHWARZ, MARLENE C.
	<b>Examiner</b> Erma Cameron	<b>Art Unit</b> 1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 December 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Specification***

1. The use of the trademark such as those on page 17 and elsewhere has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The applicant has corrected some typographical errors in the trademarks, but appears to not have capitalized ALL trademarks.

Correction is requested.

***Claim Rejections - 35 USC § 112***

2. Claims 2 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner cannot find where in the specification as originally filed the expression “translating the medical device relative to the coating head” occurs. Therefore it is new matter. [0027] states that “the coating head 20 can translate relative to the medical device 11”, but does not say that the medical device translates relative to the coating head.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The rejection of Claims 14, 26 and 28-29 under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendment filed 12/13/2005.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 12-19 and 22-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bhave et al (5861195).

‘195 teaches slide coating of multiple layers of polymer and solvent onto photographic film, which would be inclusive of X-ray film, a medical device. The slide coater has multiple blocks or plates and slots (see Abstract, Figure 2, 1:15-33, see Examples). The film is translated along to the site of the coating head and rotated before it. ‘195 teaches that the process can be applied to curtain coating (17:1-6). The coating backup roller 32 serves as a holder for the film.

Regarding the addition of “implantable” to claims 1 and 16: “implantable” is merely intended use of the medical device, and no actual implantation has occurred. It is the examiner’s opinion that ‘195 still reads on the claims as stated.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9-11, 20-21 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al (6616765).

‘765 teaches applying a coating of polymer, solvent and therapeutic substance (such as an anticoagulant) (12:45-67) to a stent thru a dispensing assembly that includes a nozzle and an orifice (6:16-35). Although ‘765 does not describe the nozzle as a slide coating head, the coating material does slide down the nozzle. Orifice 28 on the nozzle may be considered a slot. Both the stent and nozzle may move relative to each other (see the claims; 14:50-15:27).

Regarding applicant’s assertion that ‘765 teaches delivery of the coating material directly onto the medical device, it is the examiner’s position that the composition 10 gravitationally slides down the inside surface of dispenser 22 to nozzle 26, thus meeting the limitations of dispelling onto a slide surface.

Regarding whether or not high viscosity coating solution would be a problem with the ‘765 process, the instant claims are not directed to limitations of viscosity.

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al (6616765) taken in view of Lee or Valentini.

‘765 is applied here for the reasons given above.

‘765 fails to teach a vacuum at the point of coating.

Both Lee and Valentini teach a bead vacuum in a slide or slot coater (see Abstract of each).

It would have been obvious to one of ordinary skill in the art to have incorporated the bead vacuum of either Lee or Valentini to the ‘765 process because of the teaching of both Lee and Valentini that a bead vacuum is conventional in these types of coating processes.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Erma Cameron*  
ERMA CAMERON  
PRIMARY EXAMINER

Erma Cameron  
Primary Examiner  
Art Unit 1762

January 30, 2006